

PTO/SB/30 (8-00)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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# REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000  
provides for continued examination of an utility or plant application  
filed on or after June 8, 1995.  
See The American Inventors Protection Act of 1999 (AIPA).

|                        |                    |
|------------------------|--------------------|
| Application Number     | 09/509,196         |
| Filing Date            | March 23, 2000     |
| First Named Inventor   | ROGER JOHN DALY    |
| Group Art Unit         | 1646               |
| Examiner Name          | Olga N. Chernyshev |
| Attorney Docket Number | RICE-012           |

#19  
9/12

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

**NOTE:** 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

## 1. Submission required under 37 C.F.R. § 1.114

- a. ☒ Previously submitted
- i. ☒ Consider the amendment(s)/reply and exhibits submitted therewith under 37 C.F.R. § 1.116 previously filed on April 3, 2002.  
(Any unentered amendment(s) referred to above will be entered)
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- iii. ☐ Other \_\_\_\_\_
- b. ☒ Enclosed
- i. ☒ Amendment/Reply/Submission 37 C.F.R. § 1.114(c)
- ii. ☒ Applicant claims small entity status. See 37 CFR §1.27
- iii. ☒ Request for Refund under 37 C.F.R. §1.26 and 37 C.F.R. §1.28(a)
- iv. ☐ Other \_\_\_\_\_

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

## 3. Fees The RCE fee under 37 C.F.R. § 1.17 (e) is required by 37 C.F.R. § 1.114 when RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 50-0815
- i. ☒ RCE fee required under 37 C.F.R. § 1.17 (e)
- ii. ☐ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)
- iii. ☒ Fee Transmittal
- b. ☒ Check in the amount of \$ 570.00 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

|                   |                         |                                   |              |
|-------------------|-------------------------|-----------------------------------|--------------|
| Name (Print/Type) | Carol L. Francis        | Registration No. (Attorney/Agent) | 36,513       |
| Signature         | <i>Carol L. Francis</i> | Date                              | July 3, 2002 |

## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Patent and Trademark Office as a facsimile transmitted to the following number: (703) 308-0294 on this date: July 3, 2002.

|                   |                            |      |              |
|-------------------|----------------------------|------|--------------|
| Name (Print/Type) | Steven F. Goldstein        | Date | July 3, 2002 |
| Signature         | <i>Steven F. Goldstein</i> |      |              |

Burdan Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND Fees and Completed Forms to the following address: Assistant Commissioner for Patents, Box RCE, Washington, DC 20231.

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D. HICKETEN

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|---|--------------------|-------------------------|---------------------|
| I hereby certify that this correspondence is being sent by facsimile transmission to the United States Patent and Trademark Office at the 1646 Art Unit's following fax number, on this date: <u>July 3, 2002</u> |                    |                         |                     |
| Typed or Printed Name   |                    | <u>Steven Goldstein</u> |                     |
| Signature   | <u>[Signature]</u> | Date                    | <u>July 3, 2002</u> |

|  |                                  |   |
|--|----------------------------------|---|
| <b>SUBMISSION</b><br><b>UNDER 37 C.F.R. §1.114(c)</b><br><br>Address to:<br>Assistant Commissioner for Patents<br>Washington, D.C. 20231 | Attorney Docket Confirmation No. | RICE-012<br>8868  |
|  | First Named Inventor             | Roger John Daly   |
|  | Application Number               | 09/509,196  |
|  | Filing Date                      | March 23, 2000  |
|  | Group Art Unit                   | 1646  |
|  | Examiner Name                    | Olga N. Chernyshev  |
|  | Title                            | POTENTIAL EFFECTOR FOR THE GRB7 FAMILY OF SIGNALLING PROTEINS |

Sir:

This submission accompanies a Request for Continued Examination.

The Advisory Action mailed April 11, 2002 indicated that while the amendments set forth in the Amendment mailed April 3, 2002 would be entered for purposes of appeal, the exhibits submitted therewith were not considered on the grounds that the exhibits were not directed solely to issues which were newly raised by the Examiner in the final rejection.

37 C.F.R. §1.114(c) requires that a Request for Continued Examination include a "submission." As set out in this rule, a "submission" can be "new evidence of patentability."<sup>1</sup>

Applicants hereby request consideration of the exhibits not yet considered – and the argument the exhibits support – as submitted with the Amendment mailed April 3, 2002. Since the Advisory Action indicates that such exhibits have not been considered, applicants respectfully submit that the exhibits are "new evidence of patentability" and thus qualify as a "submission" as required by 37 C.F.R. §1.114(c).

Applicants further request entry of the amendments set forth in the Amendment mailed April 3, 2002 to the extent these have not yet been entered. The Advisory Action indicated that such

<sup>1</sup> 37 C.F.R. §1.114 Request for continued examination.

(c)A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C.132 is outstanding, the submission must meet the reply requirements of § 1.111.

Atty Dkt. No.: RICE-012

USSN: 09/509,196

amendments would be entered "for purposes of Appeal". For clarity's sake, applicants request entry of the amendments presented on April 3, 2002 for the purposes of further prosecution in accordance with the presently filed Request for Continued Examination.

In view of applicants' request that the Examiner consider exhibits not previously considered, and in view of the filing of the Request for Continued Examination, applicants respectfully request that the Examiner withdraw the finality of the prior Office Action, and enter and consider the submission.<sup>2</sup>

Applicants note that, after entry of the amendments of April 3, 2002, claims 1-21 are pending. Claims 1-7 and 19-21 are under consideration, and claims 8-18 are withdrawn as being directed to a non-elected invention.

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<sup>2</sup> 37 C.F.R. §1.114 Request for continued examination

(d) If an applicant timely files a submission and fee set forth in §1.17(c), the Office will withdraw the finality of any Office action and the submission will be entered and considered. . . .

Atty Dkt. No.: RICE-012  
USSN: 09/509,196

### CONCLUSION

If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RICE-012.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date:

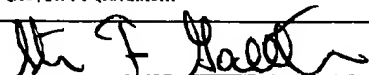
July 3, 2002

By:

Carol L. Francis  
Carol L. Francis  
Registration No. 36,513

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200 Middlefield Road, Suite 200  
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| Typed or Printed Name  | Steven F. Goldstein   |                      |                     |
| Signature  |  | Date                 | July 3, 2002        |
| <b>NOTIFICATION OF CHANGE OF ENTITY STATUS UNDER 37 C.F.R. §1.27(g)(1)</b><br><br>Address to:<br><b>BOX ISSUE FEE</b><br>Assistant Commissioner for Patents<br>Washington, D.C. 20231                          |   | Attorney Docket      | RICE-012            |
|  |   | First Named Inventor | DALY, ROGER JOHN    |
|  |   | Application Number   | 09/509,196          |
|  |   | Confirmation No.     | 8868                |
|  |   | Filing Date          | March 23, 2000      |
|  |   | Group Art Unit       | 1646                |
|  |   | Examiner Name        | CHERNYSHEV, OLGA N. |

Sir:

This communication is to inform the U.S. Patent and Trademark Office that the above-identified patent application is entitled to small entity status. Accordingly, Small entity fees are being submitted with the Request for Continued Examination (attached hereto).

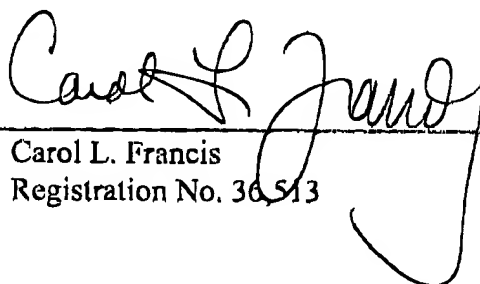
The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RICE-012.

Respectfully submitted,  
 BOZICEVIC, FIELD & FRANCIS LLP

Date:

July 3, 2002

By:

  
 Carol L. Francis  
 Registration No. 36,513

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I hereby certify that this correspondence is being sent by facsimile transmission to the United States Patent and Trademark Office at the 1646 Art Unit's following fax number: (703) 308-0294 on this date: July 3, 2002.

|                       |   |      |              |
|-----------------------|---|------|--------------|
| Typed or Printed Name | Steven Goldswain  |      |              |
| Signature             |  | Date | July 3, 2002 |

|   |   |                    |
|---|---|--------------------|
| <b>REQUEST FOR REFUND<br/>UNDER 37 CFR § 1.26 AND<br/>37 CFR § 1.28(a)</b><br><br>Address to:<br><br>Assistant Commissioner for Patents<br>Washington, D.C. 20231 | Attorney Docket   | Rice-012           |
|   | Application Number  | 09/509,196         |
|   | Filing Date   | March 23, 2000     |
|   | Confirmation Number   | 8868               |
|   | First Named Inventor  | Roger John Daly    |
|   | Examiner  | Olga N. Chernyshev |
|   | Group Art Unit.   | 1646               |
| Title:  | "A Potential Effector for the GRB7 Family of Signalling Proteins" |                    |

Sir:

This is a request for a refund under 37 CFR § 1.26(a) and § 1.28(a) for one half of the large entity fee for:

| Item Filed  | Date Mailed   | Large Entity Fee Paid |
|---|---------------|-----------------------|
| 1. Notice of Appeal   | May 3, 2002   | 320.00                |
| 2. Fee for additional Extension of time   | May 3, 2002   | 290.00                |
| 3. Fee for 1 Month Extension of Time filed with Response to Final Office Action | April 3, 2002 | 110.00                |
| <b>Which Large Entity Fees Total</b>  |               | <b>720.00</b>         |

**The Small entity fee for the above items is \$360.00.**

The Commissioner was authorized to charge the large entity fees set out above to Deposit Account No. 02-2135 in the above-identified application.

The Garvan Institute of Medical Research, the assignee of the above-identified application, is entitled to claim small entity status (See 37 CFR §1.27). Small entity status is hereby claimed and is proper.

Atty Docket No. RICE-012  
USSN: 09/509,196

In compliance with 37 CFR § 1.26(b) and 37 CFR § 1.28(a) this request for refund of the excess amount is filed within three months of the date of the timely payment of the large entity fees set out above.

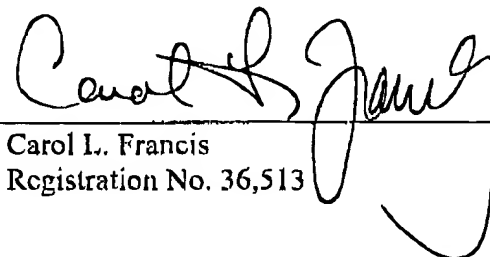
Please deposit the refund in the amount of \$360.00 into Deposit Account No. 50-0815. Please reference RICE-012.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date:

July 3, 2002

By:



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